

- 9 -

BEST AVAILABLE COPY**Remarks**

This is a complete response to the Office Action mailed November 14, 2006. These remarks are proper, do not add new matter, and are not narrowing in response to a rejection over cited art, but rather serve to clarify Applicant's position that all claims are in condition for allowance.

Status of Case

In response to Applicant's request filed 6/28/2006, the Pre-Brief Panel reopened prosecution in the Decision dated 8/30/2006. However, the new non-final rejection of 11/14/2006 maintained the previous rejections on precisely the same basis and reiterates the same arguments as before that were deemed to not make the case in condition for appeal. Accordingly, in the absence of the reconsideration requested herein, this case still has the same unresolved factual issues making it not in condition for appeal.

Rejection Under Section 102

Claims 1-3, 7, 10-12, 16, 17, 20-22, 25, and 26 stand rejected as being anticipated by Staszewski '693. This rejection is respectfully traversed.

Claim 1

Applicant reiterates that the Examiner has not substantiated a prima facie case of anticipation in the record because Staszewski '693 does not identically disclose a *phase/frequency comparator...responsive to a transition location signal*. (see Applicant's Response of 11/28/2005, ppg. 13-18; Applicant's Response of 5/30/2006, ppg. 9-14)

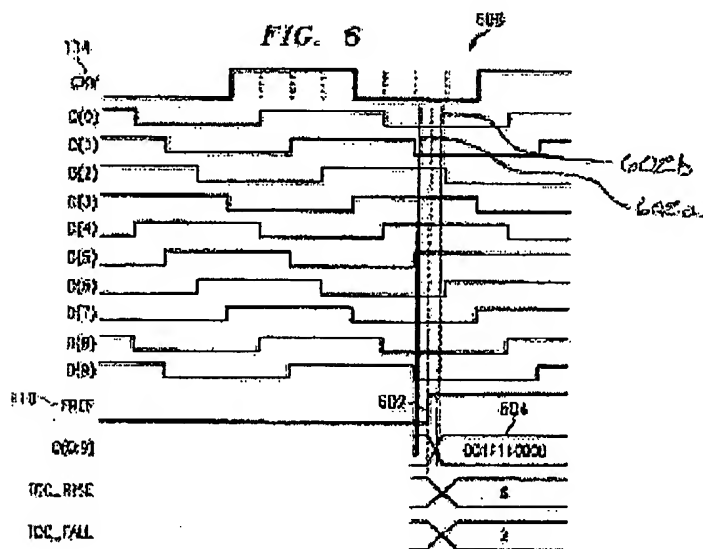
Applicant agrees with the Examiner to the extent that a reasonable claim

- 10 -

BEST AVAILABLE COPY

construction of the term *transition location signal* must be, as a matter of law, in accordance with the term's ordinary and customary meaning as understood by a skilled artisan. *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005); *In re Morris* 44 USPQ2d 1023 (Fed. Cir. 1997). What Applicant has repeatedly questioned, and the Examiner repeatedly refused to substantiate, is how the skilled artisan would reasonably view the time-to-digital signal (TDC_RISE, TDC_FALL) of Staszewski '693 as anticipating the transition location signal of the present embodiments as claimed.

Applicant reiterates that the time-to-digital signal of Staszewski '693 clearly does not indicate the location of the transition as plainly claimed. Applicant has argued in the record that FIG. 6 of Staszewski '693 clearly shows that there are a plurality of different locations associated with the same time-to-digital signal (digital word 604). For example, FREF transition locations indicated by 602a and 602b produce the same time-to-digital signal as location 602 does. (see Applicant's Response of 5/30/2006, pg. 12)



- 11 -

BEST AVAILABLE COPY

Accordingly, Applicant has substantiated evidence in the record that the Examiner's claim construction that Staszewski '693 identically discloses a *transition location signal* is unreasonable for being based on a mischaracterization of what the cited reference actually discloses. The Examiner is obliged to substantiate a reason why the skilled artisan would reasonably view the time-to-digital signal of Staszewski '693 to indicate a *transition location signal*, when in fact its time-to-digital signal is associated with a plurality of different potential locations.

For this reason and the others in Applicant's Response of 5/30/2006 the Examiner has failed to substantiate a prima facie case of anticipation because the cited reference fails to identically disclose all the features of the present embodiments as recited by the language of claim 1. Reconsideration and withdrawal of the present rejection of claim 1 and the claims depending therefrom are respectfully requested.

Claim 10

Applicant reiterates that the Examiner has not substantiated a prima facie case of anticipation in the record because Staszewski '693 does not identically disclose *encoding circuitry coupled to the phase detecting stage*. (see Applicant's Response of 11/28/2005, ppg. 18-20; Applicant's Response of 5/30/2006, ppg. 14-17)

Again, Applicant agrees with the Examiner to the extent that a reasonable claim construction of the term *encoding circuitry* must be, as a matter of law, in accordance with the term's ordinary and customary meaning as understood by a skilled artisan. *Phillips v. AWH Corp.*; *In re Morris* What Applicant has repeatedly questioned, and the Examiner repeatedly refused to substantiate, is how the skilled artisan would reasonably view the

normalization circuit (NORM) of Staszewski '693 as anticipating the *encoding circuitry* of the present embodiments as claimed.

Applicant has argued in the record that the skilled artisan clearly recognizes that an encoding process is one that characteristically alters an input value qualitatively, not quantitatively. Applicant has also argued in the record that the skilled artisan readily recognizes that the normalization process NORM of Staszewski '693 changes the input value quantitatively, and as such it is clearly not within what would reasonably be viewed as an encoding process (see Applicant's Response of 5/30/2006, ppg. 15-16). Particularly, the NORM circuit in Staszewski '693 divides ϵ_t by the clock period in order to combine it with θ_d (Staszewski '693, col. 7 lines 21-24).

Previously, the Examiner's stated position was that the NORM of Staszewski '693 anticipated the encoding circuitry because it "converts the input signal into its equivalent binary code." (Office Action of 11/28/2005, pg. 8) Applicant argued that the Examiner's assertion was wholly unsupported by what Staszewski '693 actually discloses, and as such was a blatant mischaracterization of the cited reference. (see Applicant's Response of 5/30/2006, pg. 16) In the Office Action of 11/14/2006 the Examiner maintains the rejection but now provides no basis for it whatsoever. The Examiner is obliged to substantiate a reason why the skilled artisan would reasonably view the NORM to identically disclose the *encoding circuitry* of the present embodiments as claimed. Simply dropping the mischaracterization without providing a bona fide basis does not substantiate evidence in the record making the requisite prima facie case of anticipation.

For at least this reason and others stated in Applicant's Response of 5/30/2006 the Examiner has failed to substantiate a prima facie case of anticipation because the cited

- 13 - **BEST AVAILABLE COPY**

reference fails to identically disclose all the features of the present embodiments as recited by the language of claim 10. Reconsideration and withdrawal of the present rejection of claim 10 and the claims depending therefrom are respectfully requested.

Claim 20

Applicant reiterates that the Examiner has not substantiated a prima facie case of anticipation in the record because Staszewski '693 does not identically disclose *a signal that corresponds to a transition location of the first signal....* (see Applicant's Response of 11/28/2005, ppg. 20-22; Applicant's Response of 5/30/2006, ppg. 17-18) for the same reasons as discussed above for claim 1. Reconsideration and withdrawal of the present rejection of claim 20 and the claims depending therefrom are respectfully requested.

Rejection Under Section 103

Claims 8 and 18 stand rejected as being unpatentable over Staszewski '693 in view of Brachmann '154. This rejection is traversed because these claims are allowable as depending from an allowable independent claim, for reasons above, and providing additional limitations thereto. Reconsideration and withdrawal of this rejection are respectfully requested.

Allowable Subject Matter

Applicant acknowledges with appreciation the indication of allowability of claims 4-6, 13-15, 23, and 24. However, these claims are allowable as depending from an allowable independent claim, for reasons above, and providing additional limitations

BEST AVAILABLE COPY

- 14 -

therein. Accordingly, Applicant has opted not to place these allowable claims in independent form.

Conclusion

This is a complete response to the Office Action mailed 11/14/2006.

Applicant has also filed herewith a Request for Telephone Interview to be held before the Examiner makes the next action on the merits. The interview is necessary to discuss the unresolved issues remaining in the case, which have already been deemed sufficient to make the case not in condition for appeal.

Should any questions arise concerning this response, the Examiner is encouraged to contact the below listed Attorneys.

Respectfully submitted.

By: 

Mitchell K. McCarthy, Registration No. 38,794
McCarthy & Associates
502 West Main, Suite 609
Oklahoma City, Oklahoma 73102
Telephone: (405) 691-2798
Facsimile: (405) 661-2853